

Remarks

Favorable consideration of this application in view of the foregoing amendments and the following comments is respectfully requested.

The Pending Claims

New Claims 61-88 are pending in the application, with Claim 61 being the only independent claim.

Claims 1-60 have been cancelled without prejudice.

Support for the new claims may be found in the specification as originally filed. For example, support for the recitation that the film-forming polymer is an addition polymer of ethylenically unsaturated monomers (Claim 61) may be found at page 8, lines 1-10; for the recitation that the polymer consists of a copolymer of acrylic acid and butyl methacrylate (Claim 61) may be found at page 15, lines 17-18; for the recitation that the copolymer contains about 2-29 wt.% acrylic acid (Claim 61) may be found at page 4, lines 11-12 and page 7, lines 21-22; for the recitation that the polymer has a glass transition temperature in the range of 5 to 90° C (Claim 61) may be found at page 4, lines 9-11; for the recitation that the nail enamel composition, when applied to a nail, is capable of leaving on the nail a film having a thickness in the range of about 0.5 to 8 mils (Claim 61) may be found at page 4, lines 18-21; for the recitation that the film is water-insoluble (Claim 61) may be found at page 4, line 21 to page 5, line 2; for the recitation that the composition contains 1-25 wt.% dipropylene glycol dibenzoate (Claims 73-77) may be found at page 12, lines 9-14 and page 15, lines 5-10; for the recitation that the nail enamel composition contains 0.01-15 wt.% stearalkonium bentonite (Claims 78-80) may be found at

page 10, line 21 to page 11, line 3, and page 15, lines 21-22; for the recitation that the nail enamel composition contains 0.1-25 wt.% nitrocellulose (Claims 81 and 82) may be found at page 12, lines 1-6 and page 15, lines 21-22; for the recitation that the copolymer has a molecular weight of about 68,000 (Claims 83 and 84) may be found at page 15, lines 17-19 and page 16, lines 7-9; for the recitation that the non-aqueous solvent is comprised of isopropanol (Claims 85 and 86) may be found at page 4, lines 1-5, page 15, lines 21-22, and page 16, lines 12-13; and for the recitation that the composition contains 0.1-30 wt.% pigment (Claims 87 and 88) may be found at page 10, lines 12-14 and page 15, line 15.

The New Matter Objection

In the last Office Action the Examiner objected, under 35 U.S.C. §132(a), to the amendments to the specification that Applicants made in their Preliminary Amendment filed March 1, 2005, because those amendments allegedly introduced new matter into the disclosure. Specifically, the Examiner asserted that the amendments reciting 5-95% solvent do not find support in the specification as originally filed. Without conceding the propriety of the objection, Applicants have removed the objected-to amendments. Accordingly, Applicants submit that the objection under § 132(a) is now moot.

The Presently Claimed Invention

As presently worded, all of the claims are directed to a nail enamel composition that comprises a solution of a film-forming addition polymer in non-aqueous solvent. The polymer consists of a copolymer of acrylic acid and butyl methacrylate. Claim 61 specifies that

the copolymer contains about 2-29 wt.% acrylic acid. Claim 62 requires 2-20 wt.% acrylic acid. Claim 63 requires 5-14% acrylic acid. In addition, the claims require that the polymer have a glass transition temperature in the range of 5-90° C. The polymer constitutes about 5-95 wt.% of the composition. The claims also require that when applied to a nail, the composition is capable of leaving on the nail a water-insoluble film having a thickness in the range of about 0.5 to 8 mils.

Patentability Over The References Cited In the Last Office Action

Perronin et al. (3,991,007)

Claim 58 (now cancelled) was rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Perronin et al. In particular, the Examiner cited the disclosure in Examples 6 and 13 of Perronin. Applicants submit that Perronin does not anticipate new Claim 61, at least for the following reason: Whereas Claim 61 requires that the copolymer consist of acrylic acid and *butyl* methacrylate, Perronin uses instead a copolymer of acrylic acid and *methyl* methacrylate.

Moreover, whereas Claim 61 requires that the acrylic acid/*butyl* methacrylate copolymer be *dissolved in* the non-aqueous solvent, Perronin requires that the *methyl* methacrylate/acrylic acid copolymer be only “at least partially soluble in the . . . media of application.” (Column 4, lines 21-25.) Therefore, it is quite possible that in the ink of Perronin’s Example 6 not all of the *methyl* methacrylate/acrylic acid copolymer is dissolved off the surface of the β copper phthalocyanine pigment. If not, then the concentration of *dissolved* copolymer could be less than about 5%, which is the minimum required in Claim 61. To reach a solution concentration of about 5% in the ink of Example 6, practically all of the copolymer coating

would have to be dissolved off of the pigment particles. There is no disclosure or suggestion in Perronin that that occurs.

Example 13 of Perronin likewise discloses a β copper phthalocyanine pigment that is coated with a copolymer of methyl methacrylate and acrylic acid. In this example Perronin says that the coated pigment may be dispersed with simple stirring both in “glycerophthalic paints and in aqueous paints.” (Column 10, lines 35-54.) Perronin’s mention of “aqueous paints” is irrelevant to the present claims, since Claim 61 calls for the polymer to be dissolved in “non-aqueous solvent.” As for the “glycerophthalic paints,” there is no identification of solvent and no mention of the concentration of dissolved copolymer in the paints. Thus, Example 13 of Perronin also fails to anticipate new claim 61.

Pagano et al. (5,772,988)

Pagano et al. was cited against cancelled Claims 58 and 60, as allegedly being anticipatory thereof. As regards new Claim 61, applicants submit that Pagano is not anticipatory at least for the reason that Pagano does not disclose a polymer that “consists of” acrylic acid and butyl methacrylate. Instead, Pagano requires the presence of a third monomer in its copolymer -- namely, acetoacetoxyethyl methacrylate. (See, e.g., column 6, lines 5-20.)

Hosotte-Filbert et al. (5,681,877)

Hosotte-Filbert et al. was cited against cancelled Claim 58, as allegedly being anticipatory thereof. Applicants respectfully submit, however, that Hosotte-Filbert fails to anticipate Claim 61 at least for the reason that, whereas that claim requires the use of a copolymer of acrylic acid and *butyl* methacrylate, in each of its examples Hosotte-Filbert discloses the use of a block copolymer formed of poly(acrylic acid) blocks and poly(*methyl*

methacrylate) blocks. (See, e.g., column 5, lines 65-67 and column 8, lines 10-25.)

Bednarek et al. (6,254,878)

Bednarek et al. was cited against cancelled Claim 58 as allegedly being anticipatory thereof. Applicants submit that Bednarek fails to anticipate new Claim 61, at least for the reason that, whereas Claim 61 calls for the presence of a film-forming polymer that “consists of” a copolymer of acrylic acid and butyl methacrylate, whenever Bednarek uses a copolymer of acrylic acid and butyl methacrylate the copolymer additionally contains maleic anhydride, either alone or in combination with butyl acrylate or methyl methacrylate. (See, e.g., column 8, lines 30-39.)

Perronin et al. In View of Hosotte-Filbert et al.

Like new Claim 61, cancelled Claim 59 required the use of a copolymer that “consists of” butyl methacrylate and acrylic acid. In the last Office Action Claim 59 was rejected as allegedly being obvious over Perronin et al. in view of Hosotte-Filbert et al.

As mentioned above, Perronin discloses the use of copolymers of *methyl* methacrylate and acrylic acid to coat a β copper phthalocyanine pigment used either in an autogravure ink (Example 6), a glycerophthalic paint (Example 13), or an aqueous paint (Example 13). Also as discussed above, Perronin indicates that some unspecified amount of that copolymer coating dissolves in the solvent medium used to formulate the ink or paint.

The Examiner contended that because Perronin, in the text preceding the working examples, says that the polymer used to coat the pigment may be formed of a butyl ester of a group of “alkene-mono- or di-carboxylic acids” that contains acrylic acid, one would be motivated to modify the copolymers used in Perronin’s Examples 6 and 13 by substituting butyl

acrylate for the methyl methacrylate. If one looks at the relevant disclosure in Perronin (column 3, lines 41-58) in context, however, one sees that the language is so broad as to encompass a whole host of different homopolymers and copolymers. Butyl esters, one of the numerous different classes of monomers that Perronin says can be used to form the pigment-coating polymer, are mentioned just once, in a string of possible ester moieties that range from methyl to propylene glycol. And as for the acid moieties, methacrylate is but one of 10 different types that are specifically mentioned. There is no specific mention of butyl methacrylate. Applicants submit that this teaching is so broad and general that it cannot be considered to render *prima facie* obvious the modification of Examples 1 and 6 of Perronin in the manner the Examiner has suggested. As stated by the Court of Appeals for the Federal Circuit, “[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998). Here no such reason has been shown.

Moreover, even if one were to modify Examples 6 and 13 of Perronin by substituting butyl methacrylate for the methyl methacrylate, it still is not apparent that one would end up with a composition that comprises about 5-95 wt.% of the acrylic acid/butyl methacrylate copolymer *in solution*. To reach a solution concentration of about 5% in Example 6 would require dissolution of about all of the polymer coating off the β copper phthalocyanine pigment particles. As for Example 13, no polymer-in-solvent concentration of any level is disclosed therein, either directly or indirectly.

Accordingly, Applicants submit that new Claim 61 is not obvious over Perronin et al. in view of Hosotte-Filbert et al. at least for these reasons.

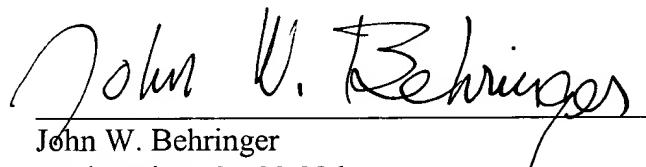
Conclusion

Applicants respectfully submit that the present invention is patentably defined by independent Claim 61. Dependent Claims 62-88 are also allowable, in their own right, for defining features of the present invention in addition to those recited in Claim 61. Individual consideration of each of the dependent claims is requested.

Applicants submit that the present application is in condition for allowance. Favorable consideration, and an early Notice of Allowability are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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